

This Opinion is Not a
Precedent of the TTAB

Oral Hearing: December 15, 2021

Mailed: March 28, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Flex Ltd.
v.
Bad Elf, LLC
—

Opposition No. 91254336
—

Pamela N. Hirschman, Autumn R. Hartman and Julie S. Shursky of Sheridan Ross
PC for Flex Ltd.

Marina F. Cunningham and Mallary S. Hein of McCormick Paulding & Huber LLP
for Bad Elf, LLC.

—
Before Lykos, Pologeorgis and Johnson,
Administrative Trademark Judges.

Opinion by Lykos, Administrative Trademark Judge:

On June 24, 2019, Bad Elf, LLC (“Applicant”) filed an application to register on
the Principal Register the standard character mark FLEX for

Global positioning system (GPS) apparatus; Global
positioning system (GPS) receivers in International Class
9; and

GPS navigation services in International Class 39.¹

Flex Ltd. (“Opposer”) opposes registration of Applicant’s mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), as to both International Classes of goods and services, on the ground of likelihood of confusion. In the Notice of Opposition, Opposer pleaded ownership of Registration No. 4995935² for the standard character mark FLEX and Registration No. 4930741³ for the stylized mark , both issued on the Principal Register for the same services identified below:⁴

Supply chain management services; transportation logistics services, namely, arranging the transportation of goods for others; logistics management in the field of electronics; procurement, namely, purchasing electronics for others and inventory management services for others; wholesale distributorship services in the field of electronics, in International Class 35;

Packaging articles to the order and specification of others, in International Class 39; and

Manufacturing services for others in the field of electronics to order and/or specification of others; custom manufacture of electronics for others; technical support services,

¹ Application Serial No. 88486090, filed under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), claiming a bona fide intent to use the mark in commerce.

Citations to the record throughout the decision include references to TTABVUE, the Board’s online docketing system. The number preceding “TTABVUE” corresponds to the docket entry number; the number(s) following “TTABVUE” refer to the page number(s) of that particular docket entry. *See, e.g., Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014).

² Registered July 12, 2016.

³ Registered April 5, 2016.

⁴ Opposer properly made of record for trial its pleaded registrations by submitting printouts from the Trademark Status & Document Retrieval (“TSDR”) database showing current status and title of each registration with its Notice of Opposition. *See* Trademark Rule 2.122(d)(1); 37 C.F.R. § 2.122(d)(1).

namely, providing technical advice related to the manufacture of electronics, in International Class 40.

Opposer also pleaded ownership of Registration No. 5352889 for the standard character mark FLEX PULSE on the Principal Register for the following goods and services:⁵

Computers; computer software for use in supply chain management, logistics and operations management, quality control, inventory management, and scheduling of transportation and delivery; Computer software in the nature of downloadable mobile applications for use in supply chain management, logistics and operation management, quality control, inventory management, and scheduling of transportation and delivery, in International Class 9;

Supply chain management services; logistics management in the field of electronics; procurement, namely, purchasing of electronics, computer hardware and computer software, purchasing and sourcing of computers, computer systems and components and inventory management services for others; wholesale distributorship and ordering services and wholesale services via direct solicitation by sales agents, in the field of electronics; inventory control and inventory management services, in International Class 35; and

Engineering services; product development services; product design, engineering, research, development and testing services in the field of electronics; design and testing for new product development; information, consultancy and advisory services relating to all the aforementioned services; providing temporary use of non-downloadable computer software for supply chain management, logistics and operation, inventory control, inventory management and tracking of documents and products over computer networks, intranets and the internet in the field of supply chain management, in International Class 42.

⁵ Registered December 12, 2017 under Section 44(e) of the Trademark Act.

In its answer, Applicant admitted that “Applicant’s alleged use of Applicant’s Mark and filing of U.S. Trademark Application Serial No. 88/486,090 is without Opposer’s consent or authorization.”⁶ Otherwise, Applicant denied the salient allegations of the Notice of Opposition. Applicant asserted various “affirmative defenses” which the Board construes as amplifications of its denials.⁷

The case is fully briefed. An oral hearing was held on December 15, 2021. Opposer, as plaintiff in this proceeding, bears the burden of establishing its statutory entitlement to a cause of action and Section 2(d) claim by a preponderance of the evidence. *See Jansen Enters. Inc. v. Rind*, 85 USPQ2d 1104, 1107 (TTAB 2007).

I. Opposer’s Evidentiary Objections

Before discussing the substantive issues before us, we consider Opposer’s objections to certain materials submitted under Applicant’s Notice of Reliance.

A. Exhibit D - Applicant’s First Set of Interrogatories to Opposer, dated and Opposer’s Responses to Applicant’s First Set of Interrogatories

1. Opposer’s Responses to Interrogatory Nos. 3, 9, 10, 19, 20, 23, 24, 26, 27, 28, and 29

With regard to Opposer’s responses to Interrogatory Nos. 3, 9, 10, 19, 20, 23, 24, 26, 27, 28, and 29, which were provided during discovery by producing documents pursuant to FED. R. CIV. P. 33(d), Opposer objects on the ground of relevancy. Opposer contends that because Applicant did not identify or properly introduce any documents

⁶ Answer, Para. No. 22; 4 TTABVUE 9.

⁷ 4 TTABVUE 4.

associated with these interrogatories under notice of reliance, the responses to the interrogatories are inadmissible because they are irrelevant.

Opposer's objection is overruled because the responses are relevant to Opposer's asserted Section 2(d) claim and Opposer's use of its marks. Furthermore, Trademark Rule 2.120(k)(3), 37 C.F.R. § 2.120(k)(3), is clear that an answer to an interrogatory may be submitted and made part of the record under notice of reliance by the inquiring party. However, while Opposer's interrogatory responses are admissible, their probative weight is minimal without the responsive documents in the record.⁸

2. Opposer's Responses to Applicant's Interrogatory Nos. 1-4 and 11

Opposer also objects to the use of its responses to Applicant's Interrogatory Nos. 1-4 and 11 that seek information about Applicant's commercial operations and use of its trademarks. Opposer argues that because it is relying solely on its registered trademarks to prove priority and likelihood of confusion, not prior common law rights, Opposer's use of its marks in the marketplace is irrelevant:

- Interrogatory No. 1 seeks information about "any and all GPS (Global Positioning System) apparatus, and/or receivers, accessories, or services which Opposer offers and/or sells, within the United States."
- Interrogatory No. 2 seeks information about "any and all GPS apparatus, receivers, accessories, or services which

⁸ Trademark Rule 2.120(k)(3)(ii), 37 C.F.R. § 2.120(k)(3)(ii), provides that "[a] party that has obtained documents from another party through disclosure or under Rule 34 of the Federal Rules of Civil Procedure may not make the documents of record by notice of reliance alone, except to the extent that they are admissible by notice of reliance under the provisions of § 2.122(e) or the party has obtained an admission or stipulation from the producing party that authenticates the documents."

Opposer offers and/or sells under the FLEX mark, within the United States.”

- Interrogatory No. 3 seeks information about “any and all products and services which Opposer offers and/or sells under the FLEX mark and specifically identify which are in International Class 9 and/or International Class 39, within the United States.”
- Interrogatory No. 4 seeks information about the “dates of first use in commerce anywhere and in the United States for products and services in Interrogatories 1-3.”
- Interrogatory No. 11 seeks information about “any and all channels of trade for Opposer’s products identified in Interrogatories 1-3 and 5-7.”

According to FED. R. EVID. 401, made applicable to Board proceedings by Trademark Rule 2.122(a), 37 C.F.R. § 2.122(a), “[e]vidence is relevant if: (a) it has any tendency to make a fact more or less probable than it would be without the evidence; and (b) the fact is of consequence in determining the action.” *See also* FED. R. EVID. 402 (“General Admissibility of Relevant Evidence”). Opposer is incorrect that evidence pertaining to actual use of any of its registered marks has no bearing on its Section 2(d) claim. As explained below, Applicant, in defending against Opposer’s Section 2(d) claim, argues that the absence of evidence relative to instances of actual confusion and contemporaneous use weighs against a finding of likelihood of confusion. These likelihood of confusion factors require us to look at actual market conditions to the extent there is evidence of such conditions of record. *In re Guild Mortg. Co.*, 2020 USPQ2d 10279, 2020 BL 120829, at *6-7 (TTAB 2020). Evidence concerning Opposer’s use is relevant to this inquiry. In view thereof, this objection is overruled.

B. Exhibit E - Applicant's First Set of Requests for Admission to Opposer and Opposer's Response to Applicant's First Set of Requests for Admission

Opposer objects to the submission of Opposer's responses to Applicant's First Set of Requests for Admission consisting of denials. Opposer's objection is sustained. While an admission to a request for admission may be properly admitted into evidence via notice of reliance under Trademark Rule 2.120(k)(3)(i), the rule does not apply to denials. *See Turdin v. Trilobite*, 109 USPQ2d at 1477 (sustaining objection to submission of denial of request for admission). "[U]nlike an admission (or a failure to respond which constitutes an admission), the denial of a request for admission establishes neither the truth nor the falsity of the assertion, but rather leaves the matter for proof at trial." *Peterson v. Awshucks SC, LLC*, 2020 USPQ2d 11526, at *1 n.9 (TTAB 2020). Consistent therewith, we have only considered Opposer's admissions.

C. Exhibit F - Applicant's First Request for Production of Documents and Things and Opposer's response to Applicant's First Request for Production of Documents and Things

Opposer objects to Applicant's submission under notice of reliance to Opposer's response to Applicant's First Request for Production of Documents and Things. Opposer argues that while Trademark Rule 2.120(k)(3)(i) permits the introduction of certain discovery materials through a notice of reliance, it does not include any provision for the submission of a party's response to requests for production because it is not a discovery deposition, an answer to an interrogatory, an admission to a request for admission, or a written initial disclosure.

Opposer's objection is sustained in part and overruled in part. Responses to document requests indicating that no documents exist may be submitted by notice of reliance. *See ShutEmDown Sports Inc. v. Lacy*, 102 USPQ2d 1036, 1038 n.7 (TTAB 2012); *see also City Nat'l Bank v. OPGI Management GP Inc./Gestion OPGI Inc.*, 106 USPQ2d 1668, 1674 n.10 (TTAB 2013) (responses to document production requests are admissible solely for purposes of showing that a party has stated that there are no responsive documents). Accordingly, Opposer's written responses that it had no documents responsive to Document Request Nos. 11, 12, and 14 are admissible.

D. Exhibit G – Internet Materials

1. Search Engine Results

Opposer objects to the submission of a screenshot of Trademark Electronic Search System (“TESS”) search results for registered marks containing the word FLEX in International Class 9 and a screenshot of Google® search engine results containing the terms FLEX GPS.⁹

We sustain Opposer's objection to the TESS search results. *See Lebanon Seaboard Corp. v. R&R Turf Supply Inc.*, 101 USPQ2d 1826, 1829 n.8 (TTAB 2012) (summary of search results from USPTO's electronic database is not an official record of the Office). In order to properly make third-party registrations of record, a party must submit a full copy of the registration or printout from a USPTO database. *See* TBMP § 704.03(b)(1)(B).

⁹ Applicant's Notice of Reliance, 9 TTABVUE 116-118, 131-132.

However, with regard to the Google® search engine results, the objection is overruled. *See Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1759 (TTAB 2013), *aff'd*, 565 F. App'x 900 (Fed. Cir. 2014) (mem.). (results from search engine introduced by testimony admissible but of limited probative value because they lack sufficient context). The Board has considered the evidence with the caveat that the probative weight is limited. The search engine results do not show the context in which the term or phrase is used on the listed web pages and do not include sufficient surrounding text to show the context within which the term or phrase is used.

2. Cumulative Materials

Opposer seeks to exclude the following printouts from two third-party websites on the ground that the materials are cumulative: website printouts corresponding to Registration No. 5271180 for the mark FLEX, and Registration No. 5706535 for the mark VDO FLEX LIGHT.¹⁰ Opposer argues that the corresponding product web pages provide no additional information about the registrations that is not provided by the registrations themselves. Based on this reasoning, Opposer takes the position that the website excerpts are cumulative and thus should be excluded.

Internet website printouts may be objectionable under FED. R. EVID. 403 on the ground that they are “needlessly presenting cumulative evidence.” Consistent therewith, the Board strongly discourages the submission of cumulative evidence. *See* TBMP § 702.05. For example, “[i]t is not necessary for the parties to introduce every

¹⁰ Applicant’s Notice of Reliance, 9 TTABVUE 133-135, 189-196.

document obtained from an Internet search especially when it includes duplicative and irrelevant materials.” *Safer, Inc. v. OMS Investments, Inc.*, 94 USPQ2d 1031, 1040 n.19 (TTAB 2010). *See also Alcatraz*, 107 USPQ2d at 1759 (relevant, representative sample of articles obtained from Internet database sufficient and preferred; parties discouraged from submitting all results), *aff’d*, 565 F. App’x 900 (Fed. Cir. 2014) (mem.). By no stretch of the imagination is the submission of excerpts from two third-party websites, corresponding to registered marks also of record, cumulative. Indeed, when an applicant challenges the strength of an opposer’s pleaded mark based on the existence of similar third-party registered marks for similar products or services, the applicant can bolster the probative value of such registrations with evidence of use. *See Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015) (Board erred in failing to give proper weight to evidence of third-party registrations depicting paw prints and evidence of these marks being used in internet commerce for clothing). Opposer’s objection is therefore overruled.

II. The Record

The record includes the pleadings, and pursuant to Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), Applicant’s application file.

A. Opposer’s Main Trial Period

Opposer introduced the testimony declaration of Bjorn Kilburn, an employee of Opposer from January 2017 to February 2020, and the former “Vice President of Product & Engineering and General Manager of Tracking & Telematics Solutions

Business Unit,” with Exhibits A-D attached thereto (8 TTABVUE).

Opposer also introduced the following evidence under Notice of Reliance on February 24, 2021 (7 TTABVUE):

1. Exhibit A – TSDR status printouts for Opposer’s pleaded registrations:¹¹

a. Exhibit A.1: FLEX (standard characters), Registration No. 4995935;

b. Exhibit A.2: FLEX (stylized), Registration No. 4930741; and

c. Exhibit A.3: FLEX PULSE (standard characters), Registration No. 5352889.

2. Exhibit B – Applicant’s discovery responses:

a. Exhibit B.1: Applicant’s Responses To Opposer’s First Requests For Admission (Nos. 1 - 46).

b. Exhibit B.2: Applicant’s Objections And Responses To Opposer’s First Set Of Interrogatories (Nos. 1 - 40).

3. Exhibit C.1 to C.30 – Photocopies of 30 third-party registrations for both tracking software and devices in International Class 9, and supply chain and logistics services in Classes 35, 39 and 42.

4. Exhibit D

a. Exhibit D.1: Opposer’s U.S. Patent Application No. 15604485 related to asset tracking technology.

b. Exhibit D.2: Opposer’s U.S. Patent Application No. 16665766 related to asset tracking technology.

¹¹ Opposer’s submission of copies of its pleaded registrations was superfluous insofar as it had previously made the registrations of record with its notice of opposition. *See, e.g., ITC Entm’t Grp. Ltd. v. Nintendo of Am. Inc.*, 45 USPQ2d 2021, 2022-23 (TTAB 1998) (filing duplicative submissions is a waste of time and resources, and is a burden on the Board).

c. Exhibit D.3: Opposer's Annual Report Pursuant to Section 13 or 15(D) of The Securities Exchange Act of 1934 for the fiscal year ended March 31, 2017.

d. Exhibit D.4: Opposer's Annual Report Pursuant to Section 13 or 15(D) of The Securities Exchange Act of 1934 for the fiscal year ended March 31, 2020.

5. Exhibit E – Internet articles and electronic publications showing the nature of the goods and services offered under Opposer's FLEX Marks,

a. Exhibit E.1: Internet printout from Forbes showing the goods and services offered under Opposer's FLEX PULSE mark.

b. Exhibit E.2: Internet printout from Opposer's website showing the goods and services offered under the FLEX Marks and the nature of Opposer's use of the FLEX Marks.

c. Exhibit E.3: Internet printout of a press release from Opposer's website showing the goods and services offered under the FLEX Marks and the nature of Opposer's use of the FLEX Marks.

6. Exhibit F

a. Exhibits F.1 to F.16: Internet printouts showing that entities offer both GPS devices and tracking software, supply chain tracking devices, original equipment manufacturing, original design manufacturing services, supply chain services, and/or logistics services.

b. Exhibit F.17: Internet printout from Opposer's website showing the supply chain management services offered under the FLEX Marks and the nature of Opposer's use of the FLEX Marks.

c. Exhibit F.18: Internet printout from Opposer's website showing the custom device design and manufacturing services offered under the FLEX Marks and

d. Exhibit F.19 to F.20: Internet printouts showing that entities offer both software and GPS hardware in the geospatial as well as transportation and logistics industries.

B. Applicant's Trial Period

Applicant submitted the testimony declaration of John J. Cunningham, Applicant's Chief Financial Officer and President, since February 2010 (10 TTABVUE).

Applicant's also introduced under Notice of Reliance dated May 3, 2021 the following admissible evidence (9 TTABVUE):

1. Exhibit A – Copy of the Registration Certificate for Applicant's Registration No. 6148745 for "BAD ELF FLEX".
2. Exhibit B – Copies of the Registration Certificates for Opposer's Trademark/Service Mark Registrations for the FLEX Marks.
3. Exhibit C – Copies of the Registration Certificates for third-party trademark registrations.
4. Exhibit D – Applicant's First Set of Interrogatories to Opposer and Opposer's Responses to Applicant's First Set of Interrogatories.
5. Exhibit E – Applicant's First Set of Requests for Admission to Opposer and Opposer's Responses to Applicant's First Set of Requests for Admission.
6. Exhibit F – Applicant's First Request for Production of Documents and Things and Opposer's Response to Applicant's First Request for Production of Documents and Things.
7. Exhibit G – Third-party Internet websites incorporating "FLEX" as a mark or trade name in connection with global navigation satellite systems and global positioning systems.

C. Opposer's Rebuttal Trial Period

During its rebuttal trial period, Opposer introduced under a Rebuttal Notice of Reliance dated June 15, 2021 the following documents:

1. Exhibit C

a. Exhibit C.31: TSDR printout for FLEX, Registration No. 5690118, showing unrelated goods in Class 9 to rebut the evidence identified by Applicant to support the allegation that the term "FLEX" is used in numerous company names and products.

b. Exhibits C.32 to C.61: Copies of thirty (30) third-party registered trademarks from TSDR for both tracking software and devices in Class 9, and supply chain and logistics services in Classes 35, 39 and 42.

2. Exhibit D

a. Exhibit D.5: Printouts from TTABVUE showing the proceeding status and file history of *Flex Ltd. v. Spireon, Inc.* in Opposition. No. 91252138.

b. Exhibits D.6 to D.7: Printouts of the Notice of Opposition filed by Opposer in Opposition No. 91252138 and the Scheduling Order issued by the Board in Opposition No. 91252138.

3. Exhibit F

a. Exhibits F.21 to F.22: Internet printouts to rebut the evidence identified by Applicant to support the allegation that the term "FLEX" is used in numerous company names and products.

b. Exhibit F.23: Printout from TTABVUE showing the proceeding status and file history of *Flex Ltd. v. Spireon, Inc.* in Opposition. No. 91252138.

c. Exhibits F.24 to F.26: Internet printout to rebut the evidence identified by Applicant to support the allegation that the term "FLEX" is used in numerous company names and products.

III. Entitlement to a Statutory Cause of Action

As a threshold issue, Opposer must prove entitlement to a statutory cause of action.¹² *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014), *cert. denied*, 135 S. Ct. 1401 (2015). According to Section 13(a) of the Trademark Act, 15 U.S.C. § 1063(a):

Any person who believes that he would be damaged by the registration of a mark upon the principal register, including the registration of any mark which would be likely to cause dilution by blurring or dilution by tarnishment under section 1125(c) of this title, may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office, stating the grounds therefor, within thirty days after the publication under subsection (a) of section 1062 of this title of the mark sought to be registered

To establish entitlement to a statutory cause of action under Section 13(a) of the Trademark Act, Opposer must demonstrate (1) that it is within the zone of interests protected by the statute (i.e., has a “real interest” in the outcome of the proceeding) and (2) damage proximately caused by registration (i.e., a reasonable basis for its belief in damage). *See Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at *4-8 (Fed. Cir. 2020); *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, at *3 (Fed. Cir. 2020); *see also Empresa*, 111 USPQ2d 1162. *See also Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d

¹² Our decisions have previously analyzed the requirements of Sections 13 and 14 of the Trademark Act, 15 U.S.C. §§ 1063-64, under the rubric of “standing.” Mindful of the Supreme Court’s direction in *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 125-26 (2014), we now refer to this inquiry as entitlement to a statutory cause of action. Despite the change in nomenclature, our prior decisions and those of the Federal Circuit interpreting Sections 13 and 14 of the Trademark Act remain equally applicable.

1023, 1025-26 (Fed. Cir. 1999) (defining a “real interest” as a “direct and personal stake” in the outcome of the proceeding).

The record includes a printout of Opposer’s pleaded Registration Nos. 4995935, 4930741, and 5352889 from the USPTO’s TSDR database showing current status and title.¹³ *See* Trademark Rule 2.122(d)(1), 37 C.F.R. § 2.122(d)(1). Thus, Opposer has demonstrated that it possesses a real interest in this proceeding beyond that of a mere intermeddler, and a reasonable basis for its belief of damage. *See Ritchie*, 50 USPQ2d at 1026; *see also Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 190 (CCPA 1982). We find, therefore, that Opposer has proven its entitlement to bring the instant proceeding.

IV. Section 2(d) Claim

Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), prohibits the registration of a mark that:

[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.

Thus, Opposer must prove both priority and likelihood of confusion by a preponderance of the evidence as to both opposed classes of goods and services in order to prevail.

¹³ *See* Opposer’s Notice of Reliance, Exhibits A.1-A.3; 7 TTABVUE 17-42.

A. Priority

Because, as noted above, Opposer properly made of record its valid and subsisting pleaded registrations and Applicant did not counterclaim to cancel them, priority is not at issue for the marks and the goods and services identified in each individual registration vis-à-vis both opposed classes.¹⁴ *See King Candy, Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974). *See also Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1727-28 (Fed. Cir. 2012).¹⁵

B. Likelihood of Confusion

We now consider the second element of Opposer's Section 2(d) claim, likelihood of confusion. Our analysis is based on all of the probative evidence of record. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) ("*DuPont*"). *See also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In making our determination, the Board has considered each *DuPont* factor for which there is evidence and argument. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. *See Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir.

¹⁴ *See* Opposer's Notice of Reliance, 7 TTABVUE 17-42.

¹⁵ Applicant raises the issue of whether Opposer properly pleaded prior common law rights in its FLEX marks. Applicant's Brief, p. 13; 13 TTABVUE 14. In briefing this issue, Opposer made clear that it is not relying on any purported prior common law rights in its pleaded marks to establish priority. *See* Opposer's Brief, p. 18; 12 TTABVUE 19 and Opposer's Reply Brief, p. 7; 14 TTABVUE 8.

2011); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) (“[T]he various evidentiary factors may play more or less weighty roles in any particular determination”).

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and services. *See In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks.”). These factors, and the other *DuPont* factors argued by each party, are discussed below.

As noted above, both classes of goods and services have been opposed. For Applicant’s International Class 9 goods, we will focus the likelihood of confusion analysis on Opposer’s Registration No. 5352889 for the standard character mark FLEX PULSE for the goods listed in International Class 9. However, for Applicant’s International Class 39 services, we will concentrate on Opposer’s Registration No. 4995935 for mark FLEX in standard characters for the International Class 35 services. If we find a likelihood of confusion as to those particular marks and those goods and services, we need not find it as to Opposer’s other registered marks or goods or services; conversely, if we do not find a likelihood of confusion as to those particular marks, we would not find it as to Opposer’s other registered marks for the goods and

services identified therein. *See, e.g., In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

1. The Similarity or Dissimilarity of the Marks

This *DuPont* factor involves an analysis of the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005) (quoting *DuPont*, 177 USPQ at 577). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff’d mem.*, (Fed. Cir. Sept. 13, 2019). *Accord, Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) (“It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.”) (citation omitted).

“The proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs.*, 101 USPQ2d at 1721 (quoting *Leading Jewelers Guild, Inc. v. LJOW Holdings, LLC*, 82 USPQ2d 1901, 1905 (TTAB 2007)). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *In re Binion*, 93 USPQ2d 1531, 1534 (TTAB 2009) (citing *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975)).

Because the similarity or dissimilarity of the marks is determined based on the marks in their entireties, the analysis cannot be predicated on dissecting the marks

into their various components; that is, the decision must be based on the entire marks, not just part of the marks. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). *See also Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”). “On the other hand, in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable.” *In re Nat'l Data Corp.*, 224 USPQ at 751.

a. FLEX versus FLEX PULSE

First, we compare Applicant’s FLEX mark to the mark FLEX PULSE in Opposer’s Registration No. 5352889, both in standard characters. Applicant directs our attention to the obvious visual differences, observing that its mark FLEX consists of a single word whereas Opposer’s mark FLEX PULSE is comprised of two words. Applicant also points to the differences in sound, namely the fact that Applicant’s mark consists of one syllable whereas Opposer’s mark consist of two. Applicant also contends that the marks project different meanings insofar as “FLEX is a single term that does not connote a specific product, while FLEX PULSE contains additional

matter that could lead consumers into thinking the mark is in connection with something with a heartbeat.”¹⁶

We acknowledge the differences in the marks pointed out by Applicant. However, when compared overall, we find that Applicant’s and Registrant’s marks are similar in appearance, sound, connotation, and commercial impression. Consumers do not focus on minutia such as the counting of the number of syllables in each mark, but rather on overall impressions. *See In re John Scarne Games, Inc.*, 120 USPQ 315, 315-16 (TTAB 1959) (“Purchasers of game boards do not engage in trademark syllable counting — they are governed by general impressions made by appearance or sound, or both.”).

Opposer’s registered mark FLEX PULSE commences with FLEX, the entirety of the Applicant’s mark. FLEX, as the first term in Opposer’s mark, is the dominant portion of that mark. It well established that consumers are generally more inclined to focus on the first word in a trademark. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1049 (Fed. Cir. 2018) (finding “the identity of the marks’ two initial words is particularly significant because consumers typically notice those words first”); *Palm Bay*, 73 USPQ2d at 1692 (finding similarity between VEUVE ROYALE and two VEUVE CLICQUOT marks in part because “VEUVE . . . remains a ‘prominent feature’ as the first word in the mark and the first word to appear on the label”); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992) (finding similarity between CENTURY 21 and

¹⁶ Applicant’s Brief, p. 19; 13 TTABVUE 20.

CENTURY LIFE OF AMERICA in part because “consumers must first notice the identical lead word”). Consumers, focusing on the first shared common element, may perceive the applied-for mark FLEX as a shortened form of the Opposer’s mark FLEX PULSE. *See, e.g., In re Mighty Leaf Tea*, 601 F.3d, 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010) (affirming Board decision that ML is likely to be perceived as a shortened version of ML MARK LEES, and noting that “the presence of an additional term in the mark does not necessarily eliminate the likelihood of confusion if some terms are identical.”); *Anheuser-Busch, LLC v. Innvopak Sys. Pty Ltd.*, 115 USPQ2d 1816, 1819 (TTAB 2015) (“While Opposer’s beer was originally sold under the BUDWEISER brand, customers soon began to abbreviate the mark, calling for BUDWEISER beer just by the name ‘BUD.’”); *Big M Inc. v. U.S. Shoe Corp.*, 228 USPQ 614, 616 (TTAB 1985) (“[W]e cannot ignore the propensity of consumers to often shorten trademarks and, in the present case, this would be accomplished by dropping the ‘T.H.’ in referring to registrant’s stores [T.H. MANDY].”).

In addition, while there is no explicit rule that we must find marks similar where an Opposer’s mark contains Applicant’s entire mark, the fact that it does increases the similarity between the two. *See In re Mighty Leaf Tea*, 94 USPQ2d at 1260 (applicant’s mark ML is similar to opposer’s mark ML MARK LEES both for personal care and skin products); *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406, 407 (CCPA 1967) (applicant’s mark THE LILLY for women’s dresses is similar to LILLI ANN for women’s apparel including dresses).

The marks also share a similar meaning and commercial impression. The word “flex” suggests product flexibility. Thus, the addition of PULSE to Opposer mark does

not create a significantly different overall connotation and impression than Applicant's mark.

For all the foregoing reasons, consumers familiar with the Opposer's mark FLEX PULSE are likely to perceive Applicant's mark FLEX as a variant mark denoting a product line extension. *See, e.g., Schieffelin & Co. v. Molson Cos., Ltd.*, 9 USPQ2d 2069, 2073 (TTAB 1989) ("Those consumers who do recognize the differences in the marks may believe that applicant's mark is a variation of opposer's mark that opposer has adopted for use on a different product."); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1271 (TTAB 2009) (VANTAGE TITAN "more likely to be considered another product from the previously anonymous source of TITAN medical diagnostic apparatus, namely, medical ultrasound devices"). Thus, although the marks have the noted minor differences, when we compare them in their entireties, we find that overall they are similar in appearance, sound, connotation and overall commercial impression. Accordingly, this *DuPont* factor weighs in favor of finding a likelihood of confusion.

b. FLEX versus FLEX

Now we compare Applicant's mark FLEX with Opposer's mark FLEX in Registration No. 4995935.¹⁷ To state the obvious, both marks are identical in sound, appearance, connotation and commercial impression. And because both marks are in standard characters, they could, in theory, be used in the same stylization. Therefore,

¹⁷ Applicant presented no arguments regarding the similarity or dissimilarity of the FLEX marks in its appeal brief.

this *DuPont* factor strongly favors a likelihood of confusion.

2. Strength of Opposer's FLEX Marks

Applicant postulates that the word FLEX, as it appears in Opposer's marks, is weak in the logistics and data tracking industries, making each of Opposer's marks eligible for only a narrow scope of protection. In determining the strength of a mark, we consider both its inherent strength, based on the nature of the mark itself, and, if there is evidence in the record of marketplace recognition of the mark, its commercial strength. *See In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) ("A mark's strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength (secondary meaning)."); 2 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:80 (5th ed., Dec. 2021 update) ("The first enquiry focuses on the inherent potential of the term at the time of its first use. The second evaluates the actual customer recognition value of the mark at the time registration is sought or at the time the mark is asserted in litigation to prevent another's use."). "[T]he strength of a mark is not a binary factor" and "varies along a spectrum from very strong to very weak." *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675-76 (Fed. Cir. 2015). "The weaker an opposer's mark, the closer an applicant's mark can come without causing a likelihood of confusion and thereby invading what amounts to its comparatively narrower range of protection." *Id.* at 1676 (internal citations omitted). In this case, Applicant challenges both the commercial and conceptual strength of Opposer's

mark.

a. Commercial Strength

Turning first to commercial strength, Applicant argues that “Opposer’s registered marks are in use in a marketplace saturated with similar marks in connection with logistics management, tracking, and telematics.”¹⁸ In support thereof, Applicant submitted printouts from twelve third-party websites.¹⁹ *See DuPont*, 177 USPQ at 567 (the sixth *DuPont* factor regarding third-party usage examines “[t]he number and nature of similar marks in use on similar goods [or services].”) We summarize relevant excerpts below:

Flex Light, “the flexible telematic solution” is a “compact, self-contained aftermarket device which can be installed on the vehicle’s dashboard.” Features include positioning.²⁰

Flex, “a certified custom display controller and data converter all-in-one. ... Flex™ delivers new data to the cockpit or can be a modern replacement for aging instruments.”²¹

Flex Solar Asset Tracker “can be used to track trailers, containers, generators and other assets. ... This is a great product for [trailer owners] who have large lots where employees move trailers without recording their movement.”²²

¹⁸ Applicant’s Brief, p. 33; 13 TTABVUE 34.

¹⁹ *See* Applicant’s Notice of Reliance; 9 TTABVUE 133-210.

²⁰ www.continentalautomotive.com; 9 TTABVUE 133.

²¹ MidContinent Instruments & Avionics; 9 TTABVUE 136.

²² www.gpstrackingamerica.com; 9 TTABVUE 138-139.

Flex Fleet offers “unique GPS and ELD products deliver a suite of hardware, software and data from a single source.”²³

FlexGPS: “We have a full featured White Label, cloud-based GPS tracking solutions with mobile app with everything your customer needs to track vehicles, drivers, and any kind of asset they want to track.”²⁴

Ford Navigation offers Flex GPS navigation system map updates.²⁵

Flex Solar Powered Asset Tracker is “a solar powered asset tracking solution for large assets such as trailers, heavy equipment, dry containers and more!”²⁶

“GPS Lockbox Flex sets the standard for industrial strength table cases and docking vehicle mounts. ... Deliveries? Inspections? Your table is at home in the vehicle, but sometimes you have to take it with you to get the job done.”²⁷

“The Flex Controller represents the latest design in McCain’s ATC eX series of advanced transportation controllers. Leveraging a Linux engine board, the controller has a real-time, open source operating system...”²⁸

The FL Flex is the industry’s first modular trailer tracking system. ... [It] allows you to add on sensors such as door, cargo, temperature, tire pressure etc”²⁹

“Flex Global View, UPS event management and visibility tool, provides an integrated view into your supply chain. Updated continuously by our global operating centers, Flex

²³ www.flexfleetgps.com; 9 TTABVUE 144-145.

²⁴ www.flexgps.net; 9 TTABVUE 148.

²⁵ www.fordnavigation.com; 9 TTABVUE 152.

²⁶ www.gofleet.com; 9 TTABVUE 153.

²⁷ Flex System; 9 TTABVUE 177-180.

²⁸ www.mccaininc.com; 9 TTABVUE 189.

²⁹ www.spireon.com; 9 TTABVUE 204.

Global View provides the information you need to keep your supply chain nimble, make critical decisions, and meet your customers' needs effectively.”³⁰

“Evidence of third-party use of similar marks on similar goods is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.” *Palm Bay*, 73 USPQ2d at 1693. The purpose of introducing evidence of third-party use is “to show that customers have become so conditioned by a plethora of such similar marks that customers ‘have been educated to distinguish between different [such] marks on the bases of minute distinctions.” *Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1693 (Fed. Cir. 2018) (quoting *Palm Bay*, 73 USPQ2d at 1694).

From what we can discern from the websites, approximately half pertain to logistics. The remaining excerpts involve GPS navigation services such as aftermarket GPS navigation for automotive vehicles.³¹ Thus, on this record, while FLEX is somewhat commercially weakened, we cannot find that FLEX is so commonly used as a mark in the moving, storage, and logistics industries that it falls on the weaker end of the strength spectrum, making the term commercially weak.

b. Conceptual Strength

This leaves us with Applicant’s challenge to the inherent or conceptual strength of the FLEX component of the Opposer’s mark. Applicant, relying on four third-party

³⁰ www.ups.com; 9 TTABVUE 208.

³¹ *Id.* at 24-34.

registered marks comprised of this term, argues that the cited marks are conceptually weak and entitled to only a narrow scope of protection.

Registration No. 2210058 for the typed mark FLEX on the Principal Register for “computer software used for logistics management, namely, for the management and processing of international cargo transport information in the field of the international transportation of cargo within the manufacturing, wholesale, retail and associated shipping industries, and manuals sold as a unit” in International Class 9, registered on December 15, 1998;

Registration No. 5271180 for the stylized mark FLeX on the Principal Register for “Advanced transportation controller for managing a variety of intelligent transportation systems, including traffic signal control and integration with connected or automated vehicles” in International Class 9, registered August 22, 2017;

Registration No. 5778035 for the mark FLEXRANGE on the Principal Register for, in relevant part, “navigation, guidance, tracking, targeting and map making devices, namely, global positioning system (GPS) apparatus; measuring, detecting and monitoring instruments, indicators and controllers, namely, torque gauges, torque transducers, force gauges, force transducers, bending moment gauges, bending moment transducers and electronic controlling devices for controlling torque, force and bending moment;” in International Class 9, registered June 18, 2019; and

Registration No. 5706535 for the mark VDO FLEX LIGHT on the Principal Register for “Apparatus for recording, transmission or reproduction of sound or images; navigation, guidance, tracking, targeting and map making devices, namely, navigation apparatus for vehicles in the nature of on-board computers; GPS tracking devices; Telematics apparatus and telematic terminal apparatus, namely, wireless Internet devices which provide telematic services and have a cellular phone function; Satellite transmitters” in International Class 9, registered March 26, 2019.

Active third-party registrations may be relevant to show that a mark or a portion of a mark is descriptive, suggestive, or so commonly used that the public will look to other elements to distinguish the source of the goods or services. *See, e.g., In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1751-52 (Fed. Cir. 2017); *Jack Wolfskin*, 116 USPQ2d at 1136; *Juice Generation*, 115 USPQ2d at 1674-75. In other words, “[t]hird party registrations are relevant to prove that some segment of the [marks] has a normally understood and well recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak.” *Id.* at 1675 (internal quotation marks omitted). *See also Jack Wolfskin*, 116 USPQ2d at 1136. These third-party registrations are related to Opposer’s transportation or logistics services, and therefore have some probative value. *See Omaha Steaks*, 128 USPQ2d at 1695. However, again, we are faced with similar concerns regarding the amount of evidence. We find that Applicant’s four third-party registrations are insufficient in number to be probative of any conceptual weakness of FLEX for the goods or services listed in Opposer’s pleaded registrations. Unlike *Juice Generation*, 115 USPQ2d at 1674, in which extensive evidence of third-party registrations was found to be “powerful on its face”, this record presents only a very limited number of such registrations for similar services. *See, e.g., Jack Wolfskin*, 116 USPQ2d at 1136; *In re Inn at St. John’s, LLC*, 126 USPQ2d at 1746 (four third-party registrations and no third-party uses were “a far cry from the large quantum of evidence of third-party use and third-party registrations that was held to be significant” in *Jack Wolfskin* and *Juice Generation*).

To summarize, while we find that there is some evidence of commercial weakness of the term FLEX as it pertains to Opposer's services, we do not find there is sufficient evidence of record regarding the conceptual weakness of the term. Thus, we accord the marks the breadth of protection to which inherently distinctive marks are entitled. *Bell's Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1347 (TTAB 2017).

3. The Goods and Services

Next, we compare the goods and services as they are identified in the involved application and Opposer's Registration Nos. 5352889 and 4995935. *See Detroit Athletic Co.*, 128 USPQ2d at 1052; *Stone Lion*, 110 USPQ2d at 1161; *Octocom Sys., Inc. v. Hous. Computs. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) and *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002).

The goods and services need not be identical or even competitive to find a likelihood of confusion. *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000). They need only be "related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that the goods [or services] emanate from the same source." *Coach Servs.*, 101 USPQ2d at 1722 (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)). The issue is not whether purchasers would confuse the goods and services, but rather whether there is a likelihood of confusion as to the source of these goods and services. *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1439 (TTAB 2012); *In*

re Rexel Inc., 223 USPQ 830, 831 (TTAB 1984).³²

a. Applicant's International Class 9 Goods

First we compare Applicant's "Global positioning system (GPS) apparatus; Global positioning system (GPS) receivers" in International Class 9 with Opposer's "Computers; computer software for use in supply chain management, logistics and operations management, quality control, inventory management, and scheduling of transportation and delivery; Computer software in the nature of downloadable mobile applications for use in supply chain management, logistics and operation management, quality control, inventory management, and scheduling of transportation and delivery" in International Class 9 as set forth in the FLEX PULSE registration.

³² In support of this *DuPont* factor, Opposer made of record thirty third-party registrations with its initial and rebuttal notices of reliance. *See* 7 TTABVUE 78-211; 11 TTABVUE 18-311. As a general proposition, use-based third-party registrations that cover goods or services from an opposer's registration and an applicant's application are relevant to show that the goods or are of a type that may emanate from a single source under one mark. *See Detroit Athletic Co.*, 128 USPQ2d at 1051. Here, however, the majority are registered under either Section 44(e) or Section 66(a) of the Trademark Act (Registration Nos. 5552736, 5624637, 5483017, 5557729, 5521687, 5216935, 4650822, 5372254, 5526829, 5206834, 5111567, 5499748, 5598330, 5206835, 6156358, 6187659, 5521987, 6160610, and 5946816), and therefore cannot be considered as being probative of exposure to U.S. consumers through use in commerce. *See In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993). Thus, in rendering our decision, we have considered only valid and subsisting third-party registered marks that are based on use (Registration Nos. 4442244, 5574222, 5987811, 6083281, 5947462, 5656623, 5865269, 5752143, 5941134, 5829307, and 4637946).

Applicant argues that each parties' identified goods are mutually exclusive. Specifically, Applicant contends that the goods per se are unrelated because Opposer's computer software and downloadable mobile app, as identified, are limited to the field of "supply chain management, logistics, and operations management, quality control, inventory management, and scheduling of transportation and delivery," and do not include any of Applicant's identified goods of "GPS," or "GPS apparatus or GPS receivers."

Applicant's argument is belied by its own admissions and testimony. Applicant admits that its GPS apparatus and receivers may be used by consumers in precisely the same fields as Opposer's computer software, namely, "supply chain management and logistics," "tracking and telematics," and tracking and recording the location of "mobile assets."³³ As such, the record shows that Applicant's GPS apparatus and receivers and GPS navigation services could serve the same function and purpose as Opposer's tracking software, that is, to track assets and mobile assets in the supply chain. And because Applicant's goods are unrestricted as to field of use, they could, consistent with Applicant's admissions, be used in the fields as identified in Opposer's registration. *See, e.g., In re Hughes Furniture Indus., Inc.*, 114 USPQ2d 1134, 1137 (TTAB 2015) ("Applicant's broadly worded identification of 'furniture' necessarily encompasses Registrant's narrowly identified 'residential and commercial furniture.'").

The record further shows that Applicant's and Opposer's goods are related.

³³ Opposer's Notice of Reliance, Admission Response Nos. 23, 25-27; 7 TTABVUE 49-50.

Opposer submitted the following use-based, valid and subsisting, third-party registrations that show GPS receivers or apparatus and computer software serving the same function as Opposer's software and mobile app, all registered under the same mark:

Registration No. 4442244 for the mark GEOFORCE for "Navigation and positioning transceivers, receivers, antennas, GPS receivers for use in global positioning systems, and for use in surveying, tracking, positioning, locating, mapping, measuring, communicating and other telemetry-enabled measuring and locating of objects and assets, including vehicles and persons; GPS navigation devices; Computer hardware and software system for tracking and locating objects and assets, including vehicles and persons, using GPS and machine-to-machine (M2M) devices attached to fielded assets; Global positioning system (GPS); Tracking and navigation systems, namely, GPS tracking and M2M data systems integrating GPS with satellite and cellular telecommunications navigation systems" in International Class 9;³⁴

Registration No. 5987811 for the mark BEWHERE for, in relevant part "...Global positioning system; Global positioning system (GPS) consisting of computers, computer software, transmitters, receivers, and network interface devices; Global positioning system receivers; Recorded computer software for logistics, namely, software for tracking documents, packages, freight and inventory; Recorded computer software for use in managing and controlling inventories; Recorded computer software that allows transmission of graphics to mobile telephones; global positioning system (GPS) consisting of transmitters; Recorded computer software for use in supply chain management, namely, computer software for use in providing product information relating to location and environmental conditions; Recorded computer software for inputting, accessing and downloading information related to material tracking and inventory control; Wireless cellular phone headset modules for use in collecting,

³⁴ 7 TTABVUE 88-90.

publishing, organizing, modifying, tracking, transmitting, storing, saving and sharing data, namely, audio, video, text, documents, visual data and information, namely, graphics and audio visual information; ..." in International Class 9;³⁵

Registration No. 5947462 for the mark WAVEMARK for, in relevant part, "...Global positioning system (GPS) consisting of computers, computer software, transmitters, receivers, and network interface devices; Computer software for inventory supply, tracking, cost and usage monitoring in the field of medicine and healthcare" in International Class 9;³⁶

Registration No. 5865269 for the mark OVALZ for, in relevant part, "Supply chain and logistics hardware and software for providing machine-readable variable environmental, supply chain, logistics, and product authentication information about a variety of products, namely, smart wireless tracking sensors, location labels in the nature of wireless GPS tracking devices, portable sensor apparatus in the nature of wireless GPS tracking devices, and software applications, for managing, authenticating, locating and communicating data and information regarding environmentally sensitive products during transport" in International Class 9;³⁷ and

Registration No. 5829307 for a design mark for, in relevant part, "Computer hardware and computer software for use in tracking, monitoring, and managing the condition, status, location, security and integrity of tangible assets, equipment, vehicles and cargo for measuring, tracking, reporting, and logging the status of shipments, inventory, and vehicles; Computer hardware and computer software for use with global position systems (GPS), general packet radio services (GPRS), radio frequency identification (RFID) tags, and satellite communication technologies for monitoring and managing tangible assets, equipment,

³⁵ 7 TTABVUE 150-152. Registration No. 6083281 with the same International Class 9 identification is owned by the same entity.

³⁶ 7 TTABVUE 180-182.

³⁷ 7 TTABVUE 185-186. Registration No. 5941134 with the same International Class 9 identification is owned by the same entity.

vehicles and cargo for measuring, tracking, reporting, and logging the status of shipments, inventory, and vehicles; Computer hardware and computer software for use in collecting, analyzing, and displaying data on the identity, location, and status of tangible assets, equipment, vehicles, and cargo; Computer hardware and computer software for use in analyzing and displaying mapped routes to monitor the identity, location, and status of tangible assets, equipment, vehicles, and cargo; Computer hardware and computer software to detect, alert, and respond to tampering and unauthorized access to tangible assets, equipment, vehicles, and cargo; Computer hardware and computer software for use in providing real-time alerts and updates on the location of tangible assets, equipment, vehicles and cargo to improve transit times, identify diversion of tangible assets from established routes and locations, identify theft, and recover stolen tangible assets; Computer hardware and computer software for real-time identification and tracking of the location, movement and condition of high-value tangible assets; Computer hardware and computer software for use by large organizations, manufacturers, heavy industry and governments to manage tangible assets in distributed supply chains and complex logistics to track inventory shipments; Systems for monitoring and tracking cargo conveyances comprised of temperature sensors, and electronic devices for locating and tracking programmed to use global positioning systems (GPS); ... Computer hardware and computer software for use in tracking, monitoring vehicles and driver performance; ...Computer hardware and computer software for use in supply chain logistics and cargo and inventory management and control, and monitoring and managing shipments; Computer hardware and computer software for use in tracking and monitoring the condition, status, location, security and integrity of assets, equipment, and cargo throughout a supply chain; Computer hardware and computer software for use in carton, pallet, container, and fixed position data collection and encoding for supply chain management; ... in International Class 9.³⁸

³⁸ 7 TTABVUE 197-200. Registration No. 4637946 with the same International Class 9 identification is owned by the same entity.

As a general proposition, third-party registrations that cover goods from both Opposer's registration and an Applicant's application are relevant to show that the goods are of a type that may emanate from a single source under one mark. *See, e.g., Detroit Athletic Co.*, 128 USPQ2d at 1051; *Hewlett-Packard*, 62 USPQ2d at 1004; *In re Infinity Broad. Corp.*, 60 USPQ2d 1214, 1217-18 (TTAB 2001); *Albert Trostel & Sons*, 29 USPQ2d at 1785-86; *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988). Just as we must consider the full scope of the goods as set forth in the application and registration under consideration, we must consider the full scope of the goods described in a third-party registration. *See Stone Lion*, 110 USPQ2d at 1161; *see also In re Country Oven, Inc.*, 2019 USPQ2d 443903, at *5-6 (TTAB 2019) (the terms "bakery goods" and "bakery products" in third-party registrations were sufficiently broad to encompass "bread buns").

Our determination is further bolstered by the acknowledgment of Applicant's Chief Financial Officer and President, Mr. Cunningham, that Opposer's "FLEX PULSE system may utilize a GNSS/GPS receiver as one of many sensors and components embedded in the system for delivering asset tracking products and services."³⁹ In addition, Opposer's former Vice President, Mr. Kilburn, testified that when he worked for Opposer, "he led the development of a GPS tracking hardware product business segment within Flex, focused in particular on the manufacture of GPS tracking devices for tractor trailers..." that "Opposer entered into an agreement with Geotab Inc. ("Geotab") whereby Flex manufactured GPS tracking devices sold

³⁹ Cunningham Declaration, ¶ 9; 10 TTABVUE 3.

by Geotab;” and “[a]t some time in 2018, the FLEX name was added to the GPS tracking devices for tractor trailers sold by Geotab.”⁴⁰

Based on the foregoing, we find that Applicant’s GPS apparatus and receivers are related to Opposer’s computer software and mobile app insofar as they could perform the same functions and be used in the same field. This *DuPont* factor weighs in favor of finding a likelihood of confusion for Applicant’s International Class 9 goods.

b. Applicant’s International Class 39 Services

We now compare Applicant’s “GPS navigation services” in International Class 39 with Opposer’s “supply chain management services; logistics management in the field of electronics; procurement, namely, purchasing of electronics, computer hardware and computer software, purchasing and sourcing of computers, computer systems and components and inventory management services for others; wholesale distributorship and ordering services and wholesale services via direct solicitation by sales agents, in the field of electronics; inventory control and inventory management services” in International Class 35 as identified in the FLEX registration. Where identical marks are involved, as is the case here, the degree of similarity between the goods [or services] that is required to support a finding of likelihood of confusion declines. *Shell Oil*, 26 USPQ2d at 1689), *aff’d*, 866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017).

Unrestricted, Applicant’s “GPS navigation services” can have multiple applications, including acting as a complementary service to Opposer’s “supply chain management services” and “transportation logistics services, namely, arranging the

⁴⁰ Kilburn Declaration, ¶ 11-13; 8 TTABVUE 3.

transportation of goods for others.” Opposer even touts its ability to “[i]mprove supply chain visibility, velocity and sustainability:”⁴¹

Every second counts. Your global supply chain demands real-time information about development, fulfillment, and forward and reverse logistics. In addition to real-time visibility, our integrated services capabilities and Flex Active Tracking enables you to manage and minimize supply chain disruptions on any device at any time.⁴²

Based on the record herein, we conclude that Applicant’s and Opposer’s services are complementary and can be used by professionals working in the supply chain and logistics field. *See In re Martin’s Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984) (“[C]omplementary use has long been recognized as a relevant consideration in determining a likelihood of confusion.”). *See, e.g., In re Davia*, 110 USPQ2d at 1817 (finding pepper sauce and agave related where evidence showed both were used for the same purpose in the same recipes, and thus, consumers were likely to purchase the products at the same time and in the same stores). As a result, this *DuPont* factor also favors a finding of likelihood of confusion.

4. The Established, Likely-to-Continue Channels of Trade and Classes of Consumers

We turn now to the established, likely-to-continue channels of trade and classes of consumers.

a. Applicant’s International Class 9 Goods

Applicant argues that Opposer’s computer software and mobile app are limited

⁴¹ Kilburn Declaration, 8 TTABVUE 15.

⁴² *Id.*

to the trade channels and buyers operating in the specialized field of “supply chain management, logistics, and operations management, quality control, inventory management, and scheduling of transportation and delivery.” By contrast, as Applicant contends, the testimony of its President and CEO shows that its GPS apparatus and receivers are marketed and sold exclusively to “entities engaged in field data collection” and used by customers in the Geographic Information System (“GIS”) industry.⁴³ Applicant points out that its goods, unlike Opposer’s, are also designed for personal use, meaning that the trade channels are distinct. Another distinction Applicant highlights is how the products are advertised and offered for sale to the public. Opposer’s goods are advertised on Opposer’s own business-to-consumer (“B2C”) website with no e-commerce functionality such as a shopping cart.⁴⁴ Applicant on the other hand operates a website that has an e-commerce function, with “shopping cart” and “add to cart” features, allowing consumers to purchase its GPS receivers and apparatus immediately on the website.⁴⁵

Applicant is impermissibly reading trade channel limitations into its own identification of goods. *See SquirtCo v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983) (“There is no specific limitation here, and nothing in the inherent nature of SquirtCo’s mark or goods that restricts the usage of SQUIRT for balloons

⁴³ Cunningham Declaration, ¶¶ 6-7; 10 TTABVUE 2-3.

⁴⁴ Applicant’s Notice of Reliance, 9 TTABVUE 125-130.

⁴⁵ Applicant’s Notice of Reliance, 9 TTABVUE 107-115. Applicant also argues that its products are iOS, Android, and Windows compatible and allow consumers to self-select their operating platform when utilizing their products. *See id.* We do not view this as a separate channel but merely further information as to how the goods are used.

to promotion of soft drinks. The board, thus, improperly read limitations into the registration.”). We reiterate that Applicant’s identification is unrestricted. The testimony that the goods are sold in mutually exclusive trade channels, therefore, is unpersuasive. Determining trade channels is based on the description of the goods stated in the application and registration at issue, not on extrinsic evidence of actual use. *Detroit Athletic Co.*, 128 USPQ2d at 1052. Because Applicant’s identification contains no restrictions as to channels of trade, or classes of purchasers, we must presume that the identified goods travel in the ordinary channels of trade for such goods. *See Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003). This could include Opposer’s identified trade channels and consumers. We must therefore conclude that the trade channels overlap and that the goods may be encountered by the same consumers, namely purchasers seeking computer software and mobile apps in the fields of supply chain management, logistics, and operations management, quality control, inventory management, and scheduling of transportation and delivery.

Therefore, the *DuPont* factor regarding the similarity or dissimilarity of established, likely-to-continue trade channels favors a likelihood of confusion with regard to Applicant’s Class 9 goods.

b. Applicant’s International Class 39 Services

As with its goods, Applicant argues that its GPS navigation services are designed for personal and business use in the GIS survey, and personal navigation industries,

not supply chain management and transportation logistics. Applicant maintains that these uses are distinct from uses enumerated in Opposer's registrations.

For the same reasons explained above, because Applicant's services as identified are unrestricted, they too fall in the normal trade channels for such services and target consumers meaning they could be marketed in the same fields as opposer's services. This factor similarly favors a finding of likelihood of confusion with respect to Applicant's Class 39 services.

5. Purchasing Conditions

We now consider the conditions under which the goods and services are likely to be purchased, e.g., whether on impulse or after careful consideration, as well as the degree, if any, of sophistication of the consumers. A heightened degree of care when making a purchasing decision may tend to minimize likelihood of confusion. Conversely, impulse purchases of inexpensive items may tend to have the opposite effect. *Palm Bay*, 73 USPQ2d at 1695.

Applicant argues that due to the technological nature of the involved goods and services, as well as the high degree of consumer sophistication, purchasers will make careful and discriminating buying decisions. Applicant notes that Opposer's customer base includes highly sophisticated multi-billion-dollar companies such as Abbott, Ford and Johnson & Johnson, both of which have experienced purchasing departments or agents.⁴⁶ In contrast, Applicant contends that the targeted consumer for its GPS products are professional surveyors, members of the Geographic

⁴⁶ Applicant's Notice of Reliance, 7 TTABVUE 307.

Information System (GIS) industry, and public and private entities engaged in field data collection.⁴⁷

While it is clear from the identifications that Opposer's goods and services are not designed for the average consumer, we cannot say the same about Applicant's goods and services. Nonetheless, given the inherent nature of Applicant's GPS products and navigation services, we think that even the average consumer will exercise a greater degree of care in making purchasing decisions. Accordingly, this factor weighs against finding a likelihood of confusion.

6. Actual Confusion and Contemporaneous Use

Applicant argues that the absence of evidence relative to instances of actual confusion and contemporaneous use weighs against a finding of likelihood of confusion.⁴⁸ Although it filed its application as intent-to-use, Applicant asserts in its brief, without citing any evidentiary support, that it began selling its International Class 9 goods and International Class 39 services as of November 12, 2019.⁴⁹ Applicant also points to evidence that the parties are not direct competitors.⁵⁰ Even assuming that Applicant has indeed been using its mark since November 12, 2019, the absence of any reported instances of confusion is meaningful only if the record indicates appreciable and continuous use by Applicant of its mark for a

⁴⁷ Cunningham Declaration; 10 TTABVUE 1-2.

⁴⁸ See Applicant's Notice of Reliance (Opposer's Response to Applicant's Interrogatory No. 32); 11 TTABVUE 65.

⁴⁹ Applicant's Brief, p. 36; 13 TTABVUE 37.

⁵⁰ Applicant's Notice of Reliance, 9 TTABVUE 308.

significant period of time in the same markets as those served by Opposer under its mark. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 94 USPQ2d 1645, 1660 (TTAB 2010), *aff'd*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011); *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992). In other words, for the absence of actual confusion to be probative, there must have been a reasonable opportunity for confusion to have occurred. *Barbara's Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1287 (TTAB 2007) (the probative value of the absence of actual confusion depends upon there being a significant opportunity for actual confusion to have occurred); *Red Carpet Corp. v. Johnstown Am. Enters. Inc.*, 7 USPQ2d 1404, 1406-07 (TTAB 1988); *Central Soya Co. v. North Am. Plant Breeders*, 212 USPQ 37, 48 (TTAB 1981) (“the absence of actual confusion over a reasonable period of time might well suggest that the likelihood of confusion is only a remote possibility with little probability of occurring”).⁵¹ We cannot discern the extent to which Applicant’s purported use of its FLEX mark in connection with its identified goods and services has been “appreciable” or “continuous” on the record before us. Accordingly, this factor is neutral.

⁵¹ As noted above, our analysis as to the second and third *DuPont* factors, discussing the similarity or dissimilarity of the goods and channels of trade, is based, as dictated by precedent from the Federal Circuit, on the identifications as set forth in the application and the cited registration. *See Stone Lion*, 110 USPQ2d at 1162. Accordingly, when determining those factors, we may not consider evidence of how Applicant and Registrant are actually selling their goods in the marketplace. *Id.* These *DuPont* factors, by contrast, require us to look at actual market conditions, to the extent there is evidence of such conditions of record. *See In re Guild Mortg. Co.*, 2020 BL 120829, at *6. Any lengthy absence of actual confusion during a period of known, rather than legally presumed, use in the same channels of trade could be telling. In this regard, we consider all of the evidence of record that may be relevant to the eighth *DuPont* factor.

7. Right to Exclude

The eleventh *DuPont* factor addresses any evidence that Applicant has a right to exclude third parties from using its mark on its goods or services. *See DuPont*, 177 USPQ at 567. Relying on the third-party uses and registrations of record for marks incorporating the term FLEX, Applicant argues that Opposer does not have the right to exclude Applicant from registering its FLEX mark. It appears that Applicant may have a misunderstanding as to the nature of this *DuPont* factor.

As noted, this *DuPont* factor addresses whether Applicant, not Opposer, has a right to exclude others from using its mark. Because Applicant has not provided any information about the advertising and sales of its goods sold or services rendered under its FLEX mark, and because there is no evidence that Applicant has successfully asserted its rights so as to “exclude” third parties from using its mark, this *DuPont* factor also is neutral. *See, e.g., DeVivo v. Ortiz*, 2020 USPQ2d 10153, at *15 (TTAB 2020) (citing *McDonald’s Corp. v. McSweet LLC*, 112 USPQ2d 1268, 1284-85 (TTAB 2014) (“Applicant’s sales figures and Applicant’s advertising and promotional expenditures are not sufficient to establish an appreciable level of consumer recognition.”) (internal citation omitted).

8. Balancing the *DuPont* Factors

Although we find that the relevant consumers are likely to exercise some degree of care, this is outweighed by the strong similarity and identical nature of the marks, the relatedness of the goods and services, and overlapping established, likely-to-continue channels of trade. The remaining factors discussed above are neutral. Balancing the *DuPont* factors, we find that confusion is likely (1) between Applicant’s

mark FLEX for its identified International Class 9 goods vis-à-vis Opposer's Registration No. 5352889 for the standard character mark FLEX PULSE for the goods listed in International Class 9, and (2) Applicant's International Class 39 services when compared to Opposer's Registration No. 4995935 for the mark FLEX in standard characters for the identified International Class 35 services. In reaching this conclusion, we have carefully considered all of the evidence pertaining to the relevant *DuPont* factors, as well as all of the parties' arguments with respect thereto. Accordingly, Opposer has proved likelihood of confusion by a preponderance of the evidence.

Decision: Opposer's Section 2(d) claim is sustained as to both Applicant's International Class 9 goods and International Class 39 services.